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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,840	01/27/2005	Tatsuya Tanaka	265044US0PCT	7487
22850	7590	04/08/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
LIN, KUANG Y				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
04/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,840

Applicant(s)

TANAKA ET AL.

Examiner

Kuang Y. Lin

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 17-19, 21, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,719,035 to Takayama et al .

Takayama et al. substantially show the invention as claimed except that they do not show how the forward and retraction movement of the injection screw is controlled (assuming the position retaining means as claimed includes a solenoid valve for controlling the hydraulic circuit as set forth in page 13, 2nd para. of the instant specification). However, it is conventional to use a hydraulic circuit system including valve means in an injection molding apparatus for controlling movement of the injection screw in an axial direction. It would have been obvious to use the conventional hydraulic circuit system in the apparatus

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Takayama et al. to move the injection screw in view of the conventional practice.

Applicants are advised that although Takayama et al. do not disclose a process for injection foaming material, their apparatus is capable to perform the invention as claimed.

4. Claims 20, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,719,035 to Takayama et al. as applied to claim 17 above, and further in view of US 2003/0094257 to Kono.

Kono shows to use separate cylinders for forming injection material and for injecting the material into the die cavity, respectively. Apparently, use of separate cylinders in the process of Kono has an advantage of speed up the die casting process. It would have been obvious to use the second cylinder of Kono in the apparatus of Takayama et al. to speed up the die casting process.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

6. Claims 17-22 and 24-26 are rejected under 35 U.S.C. 102(e)/(f)/(g)) as being anticipated by either US 6,840,302 or US 7,163,046.

Applicants are advised that the apparatus of these prior art references is capable of performing the invention as claimed. Applicant are also advised that the apparatus of the instant application is the same as that of prior art references (assuming the position retaining means C as claimed comprises a drive motor 19 and a screw hydraulic cylinder 21 connected to the drive motor 19 as set forth in page 21, 4th para. of the specification), yet the inventor entities are different.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 17-22 and 24-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of US Patent No. 7,163,046. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed disclosure of the patents disclose the invention as claimed except that that they do not show how the forward and retraction movement of the injection screw is controlled (assuming the position retaining means includes a hydraulic circuit as set forth in page 13, 2nd para. of the instant application). However, it is conventional to use a hydraulic circuit system in an injection molding apparatus for controlling the movement of the injection screw in an axial direction. It would have been obvious to use the hydraulic circuit system in the apparatus Takayama et al. to move the injection screw in view of the conventional practice. With respect to claims 20, 22 and 26, it is conventional to use separate cylinders for forming the injection material and for injecting the material into the die cavity, respectively.

9. Applicant's arguments filed March 12, 2008 have been fully considered but they are not persuasive.

a. Applicant's main argument is in that none of the prior art reference shows the claimed position retaining means. However, the position retaining means C of the instant application comprises a drive motor 19 and a screw hydraulic

cylinder 21 connected to the drive motor19 (see page 21, 4th para. of the instant specification. Patents '302 (col. 7, lines 3-18) and '046 (col 7, lines 10-25), respectively, also show the injection molding apparatus comprising drive motor 11 and a screw hydraulic cylinder 12 connected to the drive motor 11.

b. Assuming the position retaining means as claimed including a solenoid valve for controlling the hydraulic circuit as set forth in page 13, 2nd para. of the specification), the invention as claimed is deemed to be obvious in view of US '302 or US '046 since it is conventional to use a hydraulic circuit system including valve means in an injection molding apparatus for controlling movement of the injection screw in an axial direction.

c. With respect to claims 20, 22 and 26, Kono shows to provide separate cylinder for forming the injection material and for injecting the material into the die cavity. Thus, the claimed feature is deemed to be conventional.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuang Y. Lin whose telephone number is 571-272-1179. The examiner can normally be reached on Monday-Friday, 10:00-6:30,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kuang Y. Lin/
Primary Examiner, Art Unit 1793

Application Number**Application/Control No.**

10/522,840

Examiner

Kuang Y. Lin

**Applicant(s)/Patent under
Reexamination**

TANAKA ET AL.

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